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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,580	03/12/2004	Perry A. Cohagan	60655.8000	2579
20322	7590	04/07/2006	EXAMINER KIM, AHSHIK	
SNELL & WILMER ONE ARIZONA CENTER 400 EAST VAN BUREN PHOENIX, AZ 850040001			ART UNIT 2876	
PAPER NUMBER				

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/708,580

Applicant(s)

COHAGAN ET AL.

Examiner

Ahshik Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/13/06 (RCE).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-11,13-15 and 17-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-11,13-15 and 17-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in
5 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is
eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)
has been timely paid, the finality of the previous Office action has been withdrawn pursuant to
37 CFR 1.114. Applicant's submission filed on January 13, 2006 has been entered.

Amendment

2. Pursuant to filing of Request for Continuation Examination, the amendment filed on
November 1, 2005 is entered. In the amendment, claims 1, 4, 6, 8, 10, were amended, and claim
22 was newly added. Currently, claims 1, 3-11, 13-15, and 17-22 remain in the examination.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the
basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
20 in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
patent by another filed in the United States before the invention by the applicant for patent, except that an
international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
subsection of an application filed in the United States only if the international application designated the United
States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1 and 3-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Sehr (US
6,085,976, hereinafter "Sehr").

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Re claim 1, Sehr discloses a multiple service card (see abstract) configured to access financial services provided by the provider of financial services 33 (see figure 2; col. 7, lines 25+); access transportation services provided by service partners/providers (col. 4, lines 54) which includes transportation carriers as well as financial institutions; the payment processing means by the financial institution to the transportation carriers from the financial account of the consumer (col. 7, lines 47-64).

Re claim 3, the transportation system includes airplanes, railroads, ships, automobiles, subways, buses or rental cars (col. 7, lines 46-47).

Re claims 4 and 5, the payment for use of such services can be made real-time or can be scheduled for a batch processing (col. 26, lines 50-55). When the purchase is made, the transportation service provider account is credited and purchaser's financial account is debited (col. 10, lines 22+; col. 16, lines 20+).

Re claim 6-7, the use of card earns bonus points which can be used in purchases including travel services (col. 15, lines 29-37).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

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claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sehr (US 6,085,976, hereinafter "Sehr") in view of Fredregill et al. (US 5,923,016, hereinafter "Fredregill").

The teachings of Sehr have been discussed above.

Although Sehr mentions a carrier merchants participating in the program (col. 14, lines 53+; line 59), Sehr fails to specifically teach or fairly suggest that a loyalty point is determined by geographical area.

Fredregill discloses a computer implemented consumer transaction point (loyalty) system (see abstract) wherein a group of retailers in a particular area (see col. 1, lines 15+) participate in the system. Obviously, the same retailers outside designated locations are non-participants. A consumer may earn bonus points in participating store A can go to another participating store B and redeem the points. Accrued points, when redeemed, assumes a monetary value for actual purchases made.

In view of Fredregill's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to employ well-known location-based (or geographical area based) loyalty system to the teachings of Sehr in order to promote sales in a particular area.

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Sales may fluctuate from area to area, and use of promotion to boost sales in sagging area can be obviously contemplated by one ordinary skill in the art.

8. Claims 10, 11, 13, 14, and 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brake, Jr. et al. (US 6,032,136, hereinafter "Brake") in view of Sehr (US 6,085,976).

Re claims 10 and 16, Brake discloses a transaction card system wherein the card can be used as a transaction card and also as a credit card (see abstract). The service can be provided by a plurality of service providers (col. 2, lines 43-58). The agreed service providers are in a partner relationship among them. When a card is used both as a transaction card and a credit card, both primary party's and the primary party's service partners are provide to the customers (see figure 2; col. 5, lines 30+).

Brake does not explicitly disclose or suggest that the financial account associated with the card is used in paying for purchases of the service provider account.

Sehr, as described in paragraph 4 above, discloses a multiple service card wherein the financial account associated with the card is used for purchases provided by the service partners such as travel services.

Accordingly, it would have been obvious to one ordinary skill in the art to provide a link such that the services associated with the card can be purchased form the financial account, which is also linked to the card. Concept of universal card wherein one card can be used in virtually every transaction for the card-holder, and in view of such, enabling the card to pay for the other services associated with the card is an obvious improvement.

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Re claim 11, the card-holder can activate both transaction card and credit card by calling one customer service site (col. 4, lines 62+).

Re claim 13, the service provided can be purchasing gasoline or telephone calling time. In the embodiment of gasoline purchase, the bill is sent to the purchaser's address, implying that
5 the gasoline company keeps customer's account.

Re claim 14, the reward points can be earned by purchasing from the partners with consumer's credit (col. 1, lines 29-48; col. 3, lines 12-28)

Re claims 18-21, it is the Examiner's view that the methods recited in these claims appear to be generic process of replacing, canceling, or transferring a card account.

10 Re claim 22, the batch mode is explained in paragraph 4 under the Sehr patent.

9. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brake, Jr. et al. (US 6,032,136) as modified by Sehr (US 6,085,976) as applied to claim 10 above, and further in view of Fredregill et al. (US 5,923,016).

See paragraph 7 above.

15 10. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brake, Jr. et al. (US 6,032,136) as modified by Sehr (US 6,085,976) as applied to claim 10 above, and further in view of Downing et al. (US 5,963,647).

Brake and Sehr's teachings have been discussed above. Brake and Sehr, however, fail to specifically teach or fairly suggest of considering anti-terrorism information when extending
20 credit.

Downing teaches a system and the methods for transferring funds (see abstract) In determining approval for transfer, sender's identity is checked for international terrorism identity check (col. 6, lines 48-58).

In view of Downing's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to incorporate well-known anti-terrorism check to the teachings of Brake/Sehr in order to prevent potential terrorist activities involving credit/financial transactions. In approving someone for credit, a basic identity check is performed. In times of increasing terrorism, one ordinary skill in the art would be motivated to screen terrorist activities at root causes if possible. Issuing a credit card, or driver's license without anti-terrorism checking would be a big loophole one should not overlook.

Response to Arguments

11. Applicant's amended claims and remarks filed on January 13, 2006 have been carefully reviewed and considered. It is the Examiner's view that newly cited references to Sehr discloses what Applicant argued – exchanging information among the service providers and financial account associated with the card. Examiner also carefully considered the argument with respect to geographic area loyalty points, but it is the Examiner's view that the Fredregill patent discloses loyalty points by the area. Also see Chew (US 5,901,303; col. 8, lines 21-35) for similar subject matter.

Conclusion

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Chew (US 5,901,303); McDonald et al. (US 6,648,222); Freeman et al. (US

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6,402,039); Jun et al. (US 5,828,044); Bernstein (US 5,915,023); Infosino (US 6,715,679) disclose multiple-service cards. Applicant is respectfully suggested to carefully review these references.

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax number directly to the Examiner is (571)273-2393. The fax phone number for this Group is (703)872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished application is available for Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions or access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Ahshik Kim
Primary Examiner
Art Unit 2876
March 29, 2006